

REMARKS

Claims 1-12, 16, 17, 19-24 and 26-39 are pending in the present application.

The Examiner has required election in the present application between:

Group I, claims 12, 36-39, drawn to an optical disc medium, classified in class 720, subclass 600; and

Group II, claims 16-17, 19-24 and 26-35¹, drawn to content display of an optical disc player, classified in class 707, subclass 536.

For the purpose of examination of the present application, Applicant elects, with traverse, Group II, Claims 1-11, 16-17, 19-24, and 26-35.

This requirement for restriction is respectfully traversed for the reasons set forth below.

Applicant respectfully submits that the Examiner has failed to meet the required burden of showing that the groups of claims are independent and distinct, as required by law. 35 USC §121 specifically states that the Commissioner may require the application to be restricted if it contains two or more "independent and distinct" inventions claimed in one application. 37 CFR §1.141 and §1.142 further repeat the language that the two or more inventions must be "independent and distinct".

¹ Although page 2 of the Office Action identifies "claims 16-77, 22-24, and 29-32" as belonging to Invention Group II, this appears to be a typographical error. Since independent claims 16 and 23 are part of Group II, all claims (claims 17, 19-22, 24 and 26-35) depending thereon should be included in Group II. Further, original patent claims 1-11 are allowed and should be part of Group II since they recite a method or device.

MPEP §802.01 provides specific definitions of the meaning of the terms "independent" and "distinct". MPEP §802.01 states that the terms "independent" and "distinct" do not mean the same thing, but in fact have very different meanings. The term "independent", as set forth in MPEP §802.01, means that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". The term "distinct" means that "two or more subjects as disclosed are related, for example, as combination and part (sub-combination) thereof, ... and are patentable over each other".

The Examiner has set forth various reasons why the inventions are "distinct" from one another, by providing separate classifications for the groups, and by stating reasons why the groups are related. However, the Examiner has not met the burden of proving that the groupings are "independent" as required by the United States Code, the Code of Federal Regulations, and the Manual of Patent Examining Procedure. Further, Applicant respectfully submits that any policy set forth in the MPEP which conflicts with the requirements for both independence and distinctness is superseded by the directives of the United States Code and the Code of Federal Regulations, which specifically require both independence and distinctness between properly restrictable groupings. Accordingly, Applicant respectfully submits that the requirement for restriction is improper, and respectfully requests that the requirement for restriction be withdrawn.

Applicant respectfully submits that MPEP §802.01 states that inventions are independent where "they are unconnected in design, operation, and effect." This situation, except for species, is rarely present, since persons will seldom file an application containing disclosures of independent things. (emphasis added). MPEP §806.06 cites the intended meaning of independent inventions by citing specific examples of independence, stating "[a]n article of apparel, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example."

Applicant respectfully submits that the groups set forth by the Examiner may not be considered "independent", since the specification clearly discloses the relationship between the

subject matter of the claims of these groupings, and thus, the groupings are not wholly unrelated or "independent". Therefore, Applicant respectfully submits that the instant application is not properly restrictable, since the Examiner has not shown that the inventions are "independent" as required by the U.S. Statute.

Furthermore, the Examiner has already examined the optical disc medium claims (e.g., claim 12) as well as the method and device claims (e.g., claims 16 and 23) in the last Office Action. Thus, there is no serious undue burden on the Examiner to examine the same categories of claims as examined before. It seems both unfair and costly to force the Applicant to file a divisional application when the claims have been already examined. Thus, this restriction requirement is improper.

Accordingly, in view of the above remarks, reconsideration of the requirement for restriction, and an action on all of the claims in the application, are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong, Registration No 40,953 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

- Attached is a Petition for Extension of Time.
- Attached hereto is the fee transmittal listing the required fees.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By Esther Chong
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